

If used correctly, the United States provisional patent application is a useful and helpful tool for the small inventor, entrepreneur, and company. It is important that the applicant understand what a provisional patent application is, including the application's purpose, the rules associated with the application, as well as the pitfalls of such an application.

What is a Provisional Patent Application? What Is Its Purpose?

Since June 8, 1995, the United States Patent and Trademark Office (USPTO) has offered inventors the option of filing a provisional patent application for a patent. Such an application is designed to provide a lower-cost first-filing for a patent in the United States and to give U.S. applicants parity with foreign applicants under the GATT Uruguay Round Agreements.

A provisional patent application for patent is a U.S. national application for a patent filed in the USPTO under 35 U.S.C. §111(b). It allows for the filing a patent application without any formal patent claim(s), oath or declaration, or any information disclosure (i.e. disclosure of prior art) statement. The provisional patent application also provides the means for an applicant to establish an early effective filing date in a later filed non-provisional patent application filed under 35 U.S.C. §111(a). Additionally, the application and filing allows the term "Patent Pending" to be applied in connection with the description of the applied-for invention.

A provisional patent application has a pendency lasting 12 months from the date the provisional patent application is filed. The 12-month pendency period cannot be extended. Therefore, an applicant who files a provisional patent application must file a corresponding non-provisional patent application for patent (non-provisional patent application) during the 12-month pendency period of the provisional patent application in order to benefit from the earlier filing of the provisional patent application. In accordance with 35 U.S.C. §119(e), the corresponding non-provisional patent application must contain or be amended to contain a specific reference to the provisional patent application.

Once a provisional patent application is filed, an alternative to filing a corresponding non-provisional patent application is to convert the provisional patent application to a non-provisional patent application by filing a grantable petition, under 37 C.F.R. §1.53(c)(3), requesting such a conversion within 12 months of the provisional patent application filing date. However, converting a provisional patent application into a non-provisional patent application (versus filing a non-provisional patent application claiming the benefit of the provisional patent application) will have a negative impact on the patent term. The term of a patent that has been issued from a non-provisional patent application that has been converted from provisional patent application to a non-provisional patent application is measured from the original filing date of the provisional patent application.

By filing a provisional patent application first, and then filing a corresponding non-provisional patent application that references the provisional patent application within the 12-month provisional patent application pendency period, a patent term endpoint may be extended by as much as 12 months.

Requirements of a Provisional Patent Application

The provisional patent application must be made in the name(s) of all of the inventor(s). It can be filed up to 12 months following the date of first sale, offer for sale, public use, or publication of the invention, whichever occurs first. Please note that such pre-filing disclosures, although protected in the United States, may preclude patenting in foreign countries.

A filing date will be accorded to a provisional patent application only when it contains (1) a written description of the invention, complying with all requirements of 35 U.S.C. §112 ¶ 1; and (2) any drawings necessary to understand the invention, complying with 35 U.S.C. §113. If either of these items are missing or incomplete, no filing date will be accorded to the provisional patent application.

In addition to the written description of the invention and the requisite drawings, in order for a provisional patent application to be complete, it must also include the filing fees set forth in 37 CFR 1.16(d) as well as a cover sheet, which identifies (1) that the application as a provisional patent application for patent; (2) the name(s) of all inventors; (3) the inventor's residence(s); (4) the title of the invention; (5) the name and registration number of attorney or agent and docket number (if applicable); (6) a correspondence address; and (7) any U.S. Government agency that has a property interest in the application.¹

Benefits of a Provisional Patent Application

In addition to the benefits stated above, namely the lower-cost for first-filing, parity with foreign applicants under the GATT Uruguay Round Agreements, and the lack of required claims, oath or declarations, or information disclosure, a provisional patent application also affords the following benefits:

- Provides simplified filing with a lower initial investment with 12 months to assess the invention's commercial potential before committing to higher cost of filing and prosecuting a non-provisional patent application for patent.
- Establishes official United States patent application filing date for the invention.
- Permits authorized use of "Patent Pending" notice for 12 months in connection with the description of the invention.
- Begins the Paris Convention priority year.
- Enables immediate commercial promotion of invention with greater security against having the invention stolen.
- Permits applicant(s) to obtain USPTO certified copies.
- Provides for submission of additional inventor names by petition if omission occurred without deceptive intent (deletions are also possible by petition).

¹ A cover sheet, form PTO/SB/16, pages 1 and 2, is available at www.uspto.gov/forms/index.jsp.

Warnings Related To Provisional Patent Applications

Applicants should fully understand that a provisional patent application will not mature into a valid patent without further submissions by the applicant. Some advisors, internet websites, services companies, and firms misuse the provisional patent application process leaving the inventor with no patent. They fail to advise clients of the following information.

A provisional patent application automatically becomes abandoned when its pendency period expires, which occurs 12 months after the provisional patent application filing date, by operation of law. In order to preserve any benefit from the provisional patent application filing, applicants must file a non-provisional patent application claiming benefit of the earlier provisional patent application filing date in the USPTO before the provisional patent application pendency period expires.

Applicants whose invention is “in use” or “on sale” (see 35 U.S.C. §102(b)) in the United States should be aware that during the 12 month provisional patent application pendency period they may lose more than the benefit of the provisional patent application filing date if the 12 month provisional patent application pendency period expires before a corresponding non-provisional patent application is filed. Such an applicant may also lose the right to ever patent the invention (see 35 U.S.C. §102(b)).

Effective November 29, 2000, a claim under 35 U.S.C. §119(e) for the benefit of a prior provisional patent application must be filed during the pendency of the non-provisional patent application, and within four months of the non-provisional patent application filing date or within sixteen months of the provisional patent application filing date (whichever is later). See 37 CFR §1.78 as amended effective November 29, 2000.

Some additional warnings related to provisional patent applications include:

- The benefits of the provisional patent application cannot be claimed if the 12 month deadline for filing a non-provisional patent application has expired.
- A provisional patent application cannot result in a U. S. patent unless one of the following two events occurs within 12 months of the provisional patent application filing date: (1) A corresponding non-provisional patent application for patent entitled to a filing date is filed that claims the benefit of the earlier filed provisional patent application; or (2) a grantable petition under 37 CFR 1.53(c)(3) to convert the provisional patent application into a non-provisional patent application is filed.
- Provisional patent applications for patent may not be filed for design inventions.
- Provisional patent applications are not examined on their merits.
- Provisional patent applications for patent cannot claim the benefit of a previously-filed application, either foreign or domestic.
- It is recommended that the disclosure of the invention in the provisional patent application be as complete as possible.

- In order to obtain the benefit of the filing date of a provisional patent application, the claimed subject matter in the later filed non-provisional patent application must have support in the provisional patent application.
- If there are multiple inventors, each inventor must be named in the application.
- All inventor(s) named in the provisional patent application must have made a contribution, either jointly or individually, to the invention disclosed in the application.
- The non-provisional patent application must have at least one inventor in common with the inventor(s) named in the provisional patent application to claim benefit of the provisional patent application filing date.
- A provisional patent application must be entitled to a filing date and include the basic filing fee in order for a non-provisional patent application to claim benefit of that provisional patent application.
- There is a surcharge for filing the basic filing fee or the cover sheet on a date later than filing the provisional patent application.
- Amendments are not permitted in provisional patent applications after filing, other than those to make the provisional patent application comply with applicable regulations.
- No information disclosure statement may be filed in a provisional patent application.

Disclaimer -

The information in this article is general in nature and is not meant to substitute for advice provided by a patent practitioner. Applicants unfamiliar with the requirements of U.S. patent law and procedures should consult an attorney or agent registered to practice before the USPTO. A list of attorneys and agents can be searched at the USPTO Website at www.uspto.gov.

Richard Blank is an attorney registered to practice before the USPTO and is available for private consultation on these matters. This article, and the mailing in which it is contained, is attorney advertising.

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